Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROSCOE BEELER

Appeal No. 2002-1968
Application No. 09/574,922

ON BRIEF

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claim 45, which was substituted for finally rejected claims 15 through 32, 35 and 36 in a paper filed January 29, 2002 by FAX (note the examiner's answer, page 2). Claims 1 through 38 have been canceled. Claims 39 through 44 submitted in an amendment after final (Paper No. 6), were refused entry by the examiner (See advisory action, Paper No. 7).

Appellant's invention relates to a method for aiding a first player in throwing an ordinary baseball at a non-adhesive baseball receiving pocket portion of a glove held by a second player. The method includes providing a single, flexible target member, separate from the glove, and having a highly visible outwardly facing portion and an inwardly facing pressure sensitive adhesive layer for affixing the target member to the glove, and thereafter affixing the separate target member to the pocket portion of the glove by manually pressing the pressure sensitive adhesive layer against the pocket portion of the glove. A copy of claim 45, the only claim remaining in the application, can be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Wheeler	2,662,225	Dec. 15, 1953
Motooka et al. (Motooka)	5,584,133	Dec. 17, 1996

Claim 45 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Wheeler in view of Motooka.

Rather than reiterate the examiner's full commentary regarding the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellant regarding the rejection, we make reference to the examiner's answer (Paper No. 12, mailed April 24, 2002) for the reasoning in support of the rejection, and to appellant's brief (Paper No. 11, filed April 5, 2002) and reply brief (Paper No. 13, filed May 1, 2002) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claim 45, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination which follows.

In rejecting claim 45 under 35 U.S.C. § 103(a) on the basis of the collective teachings of Wheeler and Motooka, it is the examiner's position (answer, pages 3-4) that Wheeler discloses a targeting device for aiding a first player in throwing an ordinary baseball at a non-adhesive baseball receiving pocket

portion (11) of a glove (10) held by a second player, comprising a target member (11a) "separate from and not built into the non-adhesive baseball receiving pocket portion (11) [the dye or the like is optionally added to the oil at a later time] of the glove upon manufacture of the glove." While the examiner does not specifically enumerate any difference or differences between the claimed subject matter and that disclosed in Wheeler, the examiner makes the following comments and assertions

> Wheeler as disclosed above shows a target area that can be visually enhanced after the manufacturing of the glove, but to further clarify this limitation, Motooka et al shows a baseball glove having a name plate with removable and interchangeable inserts (indicia). Motooka clearly teaches that it is desirable that indicia which is attached to a glove be removable so that it can easily be changed. The name plate can be affixed to the glove by various means, including stitching and adhesive. It would have been obvious to one of ordinary skill in the art at the time the invention was made make the target member for the baseball glove of Wheeler removable as taught by Motooka, to permit the target to be changed. Note that constructing a formerly integral structure in various elements involves only routine skill in the art. ***Nerwin v. Erlichman***, 168 USPQ 177, 179.
>
> Regarding the means for attachment, notice was taken that pressure sensitive adhesive layers are old and well known conventional mechanical expedient of securing means and it would have been considered and [sic] obvious modification, since it would have provided a quick and easy way of affixing the target member to the glove of Wheeler. Since Appellant appears to have challenged such notice of what was old and well known, reference is made to Kanzelberger, of

> record, to show pressure sensitive means for removable indicia.[1]

Appellant contends that Wheeler discloses a baseball glove with an oil or grease containing pocket (11a) built into the glove during its manufacture and that while the oil receiving pocket can act as a visual target contrasting with the adjacent leather of the glove, especially when a suitable dye or the like is incorporated in the oil or pocket, there is no suggestion in Wheeler or the secondary reference to Motooka of appellant's contribution to the art as defined in claim 45 on appeal. In describing Motooka, appellant contends (brief, page 7) that

> Motooka should not be properly combinable with the primary reference to Wheeler because, inter alia, Motooka teaches adding a replaceable nameplate (rather than a ball target) to a baseball glove on the outside of the glove not facing the thrower, and is thus removed from the pocket ball receiving portion of the glove which faces the thrower, the nameplate thus

[1] We note the examiner's reference to Kanzelberger (US 4,384,416), but observe that this patent has not been set forth in the statement of the § 103 rejection before us, or in any other rejection made by the examiner. Accordingly, it forms no part of the issues presented for review by this panel of the Board. As pointed out by the Court in In re Hoch, 428 F.2d 1341, 1342, 166 USPQ 406, 407 (CCPA 1970), where a reference is relied upon to support a rejection, whether or not in a minor capacity, there would appear to be no excuse for not positively including the reference in the statement of the rejection.

> cannot suggest its use as a target as required by Appellant's invention.

Appellant is of the view that the examiner has erroneously rejected claim 45 based on impermissible hindsight, using the teachings of appellant's own specification rather than suggestions found in the applied prior art.

Having reviewed and evaluated the applied prior art references to Wheeler and Motooka, we share appellant's assessment of the rejection on appeal and the opinion that the examiner's position regarding the purported obviousness of claim 45 represents a classic case of the examiner using impermissible hindsight derived from appellant's own disclosure in an attempt to reconstruct appellant's claimed subject matter from disparate teachings and broad concepts purported to be present in the prior art. In our view, there is no motivation or suggestion in the applied references to Wheeler and Motooka which would have reasonably led one of ordinary skill in the art to modify the baseball glove of Wheeler and its oil receiving pocket (11a) in the particular manner urged by the examiner so as to result in appellant's claimed method.

In our opinion, if one of ordinary skill in the art were to evaluate the teachings of Wheeler and Motooka, without hindsight benefit of appellant's disclosure, such artisan would have, at best, been led to provide the glove of Wheeler with a name plate fitting (3) like that in Motooka (frame member 5 and name plate 10) mounted on the outside or back member of the glove (i.e., away from the ball receiving pocket of the glove so as not to form an obstruction to play) as taught in Motooka. Simply stated, we see nothing in Motooka or Wheeler that relates in any way to appellant's particular method of providing an after-market, single flexible target member of the particular type required in claim 45 on appeal, separate from the glove, and then affixing such target member to the pocket portion of the glove by manually pressing the inwardly facing pressure sensitive adhesive layer of the target member against the pocket portion of the glove.

Since we have determined that the teachings and suggestions which would have been fairly derived from Wheeler and Motooka would not have made the subject matter as a whole of claim 45 on appeal obvious to one of ordinary skill in the art at the time of

appellant's invention, we must refuse to sustain the examiner's rejection of that claim under 35 U.S.C. § 103(a).

In light of the foregoing, the decision of the examiner to reject claim 45 under 35 U.S.C. § 103(a) is reversed.

REVERSED

CHARLES E. FRANKFORT Administrative Patent Judge	)	
LAWRENCE J. STAAB Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

CEF/lbg

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ROBERT L NATHANS
36 STAG DRIVE
BILLERICA, MA 01821-4116